



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/375,586	08/17/99	JONES	J 11077/002001

Y ROCKY TSAO  
FISH & RICHARDSON PC  
225 FRANKLIN STREET  
BOSTON MA 02110-2804

QM02/0912

EXAMINER

BRINSON, P

ART UNIT	PAPER NUMBER
----------	--------------

3752

DATE MAILED: 09/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**09/375,586**

Applicant(s)  
**John Jones et al.**

Examiner  
**Patrick F. Brinson**

Group Art Unit  
**3752**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-46 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-46 are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8, drawn to a centrifugally cast tube, classified in class 138 , subclass 177.
  - II. Claims 9-22 and 43-46, drawn to a method of forming an end-profile in the bore of a tube of creep resistant alloy, classified in class 205, subclass 687+.
  - III. Claims 23-42, drawn to an electrochemical machining apparatus to machine an end-profile on the inside of a tube, classified in class 204, subclass 193+.
2. The inventions are distinct, each from the other because of the following reasons:
3. Inventions of Groups I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as the step of drawing an electrode having an external profile corresponding with a desired end profile of the tube from one end of the tube to its second end, as is required by the invention of Group II.
4. Inventions of Groups III and I are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be

shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product as claimed can be made by another and materially different apparatus such as one not requiring an electrode having a profile corresponding with the end-profile and mounted on the end of an insulated connector rod extending sealingly through an aperture in one of the mounting means and a power connection means to connect an electrical voltage between the tube and electrode, as is required by the invention of Group III.

5. Inventions of Groups II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as one not requiring the steps of passing an electrolyte along the tube to enable current flow and so that metal leaves the surface of the target area of the tube and enters solution in the electrolyte.

6. Because these inventions are distinct for the reasons given above and the search required for Group I and/or II is not required for Group III, restriction for examination purposes as indicated is proper.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

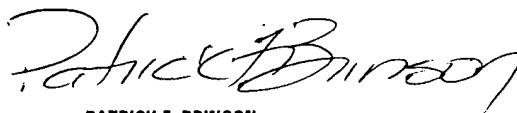
Serial Number: 09/375,586

3

Art Unit: 3752

or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **PATRICK F. BRINSON** whose telephone number is (703) 308-0111.



**PATRICK F. BRINSON**  
**PRIMARY EXAMINER**  
Tech Center 3700

P. F. Brinson  
September 8, 2000